UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,915	06/14/2001	William Kress Bodin	AUS920010502US1	8357

34533	7590	09/24/2004

IBM CORP (BLF)
c/o BIGGERS & OHANIAN, LLP
504 LAVACA STREET, SUITE 970
AUSTIN, TX 78701-2856

EXAMINER
PATEL, HARESH N

ART UNIT	PAPER NUMBER
2154	

DATE MAILED: 09/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/881,915	BODIN ET AL.
	Examiner	Art Unit	
	Haresh Patel	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>14 June 2001</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-36</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-36</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>14 June 2001</u> is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 1-36 are presented for examination.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2.   Claims 1-36 are provisionally rejected under the judicially created doctrine of

obviousness-type double patenting as being unpatentable over claims 1-22 of copending

Application No.09/882174. Although the conflicting claims are not identical, they are not

patentably distinct from each other because the limitations of independent claims 1, 13, 26 are

similar to claim 1 of copending Application No. 09/882174. The limitations "remote direction of

streaming digital content from a content server to a client devices using remote director" is

equivalent to the use of content information, transcoding gateway for providing director

instructions to stream digital content, and the use of email containing digital content. The

limitations of dependent claims 2-12, 14-23, 26-36, are similar to claims 2-22 of copending

Application No. 09/882174.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting

claims have not in fact been patented.

3.   Claims 1-36 are provisionally rejected under the judicially created doctrine of

obviousness-type double patenting as being unpatentable over claims 10-15 of copending

Application No.09/881919. Although the conflicting claims are not identical, they are not

patentably distinct from each other because the limitations of independent claims 1, 13, 26 are

similar to claim 10 of copending Application No. 09/881919. The limitation "remote direction

of streaming digital content from a content server to a client devices using remote director" is

equivalent to the use of a content server through which digital content is transcoded into streams

of multimedia data, the streams communicated via network to client devices, use of the digital

content for streaming, use of remote director instructions comprising hyperlinked URLs invoked

through a network-capable device. The limitations of dependent claims 2-12, 14-23, 26-36, are

similar to claims 11-15 of copending Application No. 09/881919.

        This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting

claims have not in fact been patented.

4.   Claims 1-36 are provisionally rejected under the judicially created doctrine of

obviousness-type double patenting as being unpatentable over claims 1-20 of copending

Application No.09/881917. Although the conflicting claims are not identical, they are not

patentably distinct from each other because the limitations of independent claims 1, 13, 26 are

similar to claim 1 of copending Application No. 09/881917. The limitation "remote direction of

streaming digital content from a content server to a client devices using remote director" is

equivalent to the use of streaming digital content from a multiplicity of sources of digital

information to a multiplicity of client devices, use of network of digital computers comprising a

content server. The limitations of dependent claims 2-12, 14-23, 26-36, are similar to claims 2-

20 of copending Application No. 09/881917.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting

claims have not in fact been patented.

5.   Claims 1-36 are provisionally rejected under the judicially created doctrine of

obviousness-type double patenting as being unpatentable over claims 1-12 of copending

Application No.09/882173. Although the conflicting claims are not identical, they are not

patentably distinct from each other because the limitations of independent claims 1, 13, 26 are

similar to claim 1 of copending Application No. 09/882173. The limitation "remote direction of

streaming digital content from a content server to a client devices using remote director" is

equivalent to the use of remote direction of streaming digital content from a multiplicity of

sources of digital information to a multiplicity of client devices upon a network of digital

computers comprising a content server receiving digital content from the sources and the digital

content having a multiplicity of digital formats. The limitations of dependent claims 2-12, 14-

23, 26-36, are similar to claims 2-11 of copending Application No. 09/882173.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting

claims have not in fact been patented.

Specification

6.   The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The present title is not sufficient for proper classification of the claimed subject matter.

7.   The disclosure is objected. Some of the informalities are:

i.   The "BRIEF SUMMARY OF THE INVENTION" section should contain brief description of the disclosed subject matter rather repetitive claimed language of the claims.

ii.   Unless the invention is created from scratch, applicant needs to provide all the prior arts that have led to the invention, i.e., existing patents and publications related to the claimed subject matter. In response, applicant is requested to provide the title, citation and copy of each publication related to the claimed subject matter. For each publication, please provide a concise explanation of that publication's contribution to the description of the prior art.

Appropriate correction is required.

Drawings

8.   New formal drawings are required in this application because submitted drawings are informal (hand drawn). Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid

abandonment of the application. The requirement for corrected drawings will not be held in

abeyance.

Claim Objections

9.   Claims 10, 14, 15, 20-23, 32-36 are objected to because of the following informalities:

All claims must have "." (period) at the end of claimed subject matter. For example,

claim 10 is missing "." (period) at the end of claimed subject matter.

Claim 14 mentions that "The system of claim 10", which is incorrect. Examiner

considers it as "The system of claim 13", for examine purpose.

Claim 15 mentions that "The system of claim 11", which is incorrect. Examiner

considers it as "The system of claim 14", for examine purpose.

Claim 20 mentions that "The system of claim 4", which is incorrect. Examiner considers

it as "The system of claim 16", for examine purpose.

Claim 21 mentions that "The system of claim 10", which is incorrect. Examiner

considers it as "The system of claim 13", for examine purpose.

Claim 22 mentions that "The system of claim 15", which is incorrect. Examiner

considers it as "The system of claim 18", for examine purpose.

Claim 23 mentions that "The system of claim 1", which is incorrect. Examiner considers

it as "The system of claim 13", for examine purpose.

Claim 32 mentions that "The computer program product of claim 25", which is incorrect.

Examiner considers it as "The computer program product of claim 28", for examine purpose.

Claim 33 mentions that "The computer program product of claim 10", which is incorrect.

Examiner considers it as "The computer program product of claim 25", for examine purpose.

Claim 34 mentions that "The computer program product of claim 15", which is incorrect.

Examiner considers it as "The computer program product of claim 30", for examine purpose.

Claim 35 mentions that "The computer program product of claim 1", which is incorrect.

Examiner considers it as "The computer program product of claim 25", for examine purpose.

Claim 36 mentions that "The computer program product of claim 17", which is incorrect.

Examiner considers it as "The computer program product of claim 29", for examine purpose.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

11.   Claims 1, 2, 4-14, 16-26, 28-36, are rejected under 35 U.S.C. 103(a) as being

unpatentable over Application Server Solution Guide, Enterprise Edition: Getting Started,

Nusbaum, May 2000, Nusbaum et. al., pages 1-45, 416-434 (Hereinafter Nusbaum) in view of

Java Media Framework API Guide, JMP 2.0 FCS, November 19, 1999, Sun Microsystems, page

1-66, 109- 135, 173-178 (Hereinafter Sun).

12.   As per claims 1, 13 and 25, Nusbaum teaches a method, a system and a computer

program product to implement remote direction of streaming digital content from a multiplicity

of sources of digital information to a multiplicity of client devices the method implemented upon

a network of digital computers (e.g., figure 5, page 13), at least one of the digital computers

comprising a content server upon which the steps of the method are implemented in computer

memory and at least one computer processor (e.g., server containing web content, page 13) the

method comprising the steps of: receiving digital content from the sources (e.g., section 1.3.2.

page 12, section 2.1.1.1, pages 31 and 32), receiving, from a remote director, and storing in

computer memory, remote director instructions, the remote director instructions including

instructions for selections of digital content for inclusion in an output streaming (e.g., section

7.4, page 375); carrying out the remote director instructions(e.g., section 7.4, page 375), wherein

carrying out the remote director instructions further comprises:

selecting, in dependence upon the remote director's instructions, digital content for

inclusion in an output stream (e.g., section 1.2.4, page 6);

in dependence upon the remote director's instructions handling the digital content from

sources (e.g., section 2.1.1.1, pages 31 and 32);

including in an output streaming, in dependence upon the remote director's instructions,

digital content (e.g., section 1.2.4, page 6);

communicating, in dependence upon the remote director's instructions, to at least one of

the client devices the output stream (e.g., section 1.2.4, page 6).

However, Nusbaum does not specifically mention about streaming digital content and

transcoding into digital content having streaming format objects and the digital content having a

multiplicity of digital formats.

Sun teaches streaming digital content and transcoding (e.g., transcoding the video contents, page 33) into digital content having streaming format objects and the digital content having a multiplicity of digital formats (e.g., streaming media, page 4, MPEG, JPEG, etc., video formatted content, page 6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Nusbaum with the teachings of Sun in order to facilitate transforming of the objects and using the digital formats for streaming digital content. The well-known concept of handling broadcast user controls would be supported the gateway/server of the Nusbaum. The Nusbaum's gateway/server would help transform / transcode information of the objects/information that are used for streaming. Any digital data can be used for transforming and can be used for streaming using various known streaming digital formats, as per Sun's teachings.

13.   As per claims 2, 14, 26, Nusbaum teaches the following:

the client devices comprise client device attributes, said transcoding further comprising transcoding in dependence upon the client device attributes (e.g., Section 1.3.1.2, page 10).

14.   As per claims 4, 16, 28, Nusbaum teaches the following:

the remote director comprises a personal computer coupled through a network to the content server (e.g., figure 1, page 2, figure 3, page 9), the method further comprising: sending from the remote director to the content server remote director instructions (e.g., servlet aliases, servlet URLs, sections 1.1 and 1.2, pages 1 and 2), further comprising involving through URLs

displayed on a terminal of the remote director member methods in servlets installed on the

content server (e.g., servlet aliases, servlet URLs, sections 1.1 and 1.2, pages 1 and 2).

15.   As per claims 5, 17, 29, Nusbaum teaches the following:

invoking through each URL a single member method in a servlet (e.g., servlet aliases,

servlet URLs, sections 1.1 and 1.2, pages 1 and 2).

16.   As per claims 6, 18, 30, Nusbaum teaches the following:

the single member method is programmed to carry out a single remote director

instruction (e.g., use of servlet aliases, servlet URLs, sections 1.1 and 1.2, pages 1 and 2).

17.   As per claims 7, 19, 31, Nusbaum teaches the following:

the single member method is implemented as a Java thread-level URL dispatch routine

(e.g., implementation of servlet aliases, servlet URLs, sections 1.1 and 1.2, pages 1 and 2).

18.   As per claims 8, 20, 32, Nusbaum teaches the following:

the remote director instruction comprises an instruction to select for transcoding and

streaming digital content from a specific source (e.g., specific source referred by servlet URL,

servlet aliases, sections 1.1 and 1.2, pages 1 and 2, figure 3, page 9).

19.   As per claims 9, 21, 33, Nusbaum teaches the following:

registering a user for a service, the service identified by a service identification code, the

service comprising at least one output stream (e.g., section 7.4, page 375);

logging in the user for the service, logging in the user further comprising assigning values

to user login attributes, the user login attributes comprising user identification, device type,

network address, and a tier (e.g., section 8.1.8.1, page 417),

assigning a tier value in dependence upon the device type and the service identification

code (e.g., section 8.1.8, page 417);

wherein the selections are dependent upon the tier (e.g., section 8.1.8.1, page 417),

wherein transcoding further comprises transcoding in dependence upon the tier (e.g.,

section 8.1.10, page 420); and

wherein communicating to at least one of the client devices the output stream further

comprises communicating the output stream to the network address (e.g., section 4.1.5.3, page

119).

20.   As per claims 10, 22, 34, Nusbaum teaches the following:

creating a service registration record comprising service registration attributes comprising

user id, service id and service subscription level; and assigning a tier value further comprises

assigning a tier value in dependence upon the service subscription level (e.g., section 7, page

363).

21.   As per claims 11, 23, 35, Nusbaum teaches the following:

registering a user for an event, the event identified by an event identitication code, the

event comprising at least one output stream, at least one source, a start date and a start time (e.g.,

section 7.4, page 375);

logging in the user for the event, logging in the user further comprising assigning values

to user login attributes, the user login attributes comprising user identification, device type,

network address, and a tier; (e.g., section 8.1.8.1, page 417),

assigning a tier value in dependence upon the device type and the event identification

code (e.g., section 8.1.8, page 417);

wherein the selections are dependent upon the tier (e.g., section 8.1.8.1, page 417),

wherein transcoding further comprises transcoding in dependence upon the tier (e.g.,

section 8.1.10, page 420); and

wherein communicating to at least one of the client devices the output stream further

comprises communicating the output stream to the network address (e.g., section 4.1.5.3, page

119).

22.   As per claims 12, 24, 36, Nusbaum teaches the following:

registering a user further comprises creating an event registration record comprising

event registration attributes comprising user id, event id, event subscription level, start date, and

start time (e.g., section 7.4, page 375); and

assigning a tier value further comprises assigning a tier value in dependence upon the

event subscription level (e.g., section 8.1.8, page 417).

23.   Claims 3, 15, 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Nusbaum in view of Sun and in further view of "Official Notice.

24.   As per claims 3, 15, 27, Nusbaum and Sun teaches the claimed limitation as rejected

under claims 2, 14 and 26. Nusbaum and Sun also discloses that the transforming of client

device attributes. However, Nusbaum and Sun does not specifically mention about client device

attributes including device type, screen size, frame rate, and audio status. "Official Notice" is

taken that both the concept and advantages of providing client device attributes include device

type, screen size, frame rate, and audio status is well known and expected in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to include client device attributes include device type, screen size, frame rate, and

audio status with the teachings of Nusbaum and Sun in order to facilitate transcoding of the

client device attributes, i.e., device type, screen size, frame rate, and audio status. The well

known concept of transforming / transcoding attributes, like, device type, screen size, frame rate

and audio status, would be possible with the teachings of transforming/transcoding mechanism.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Haresh Patel whose telephone number is 703-605-5234. The

examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 10:00 am to

8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 703-305-8498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Haresh Patel

September 2, 2004

JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100